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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

William Y. Conwell

Application No.: 09/578,551

Filed: May 25, 2000

For: CONSUMER DRIVEN METHODS
FOR ASSOCIATING CONTENT
IDENTIFIERS WITH RELATED
WEB ADDRESSES

Examiner: A. Mohammad

Date: April 19, 2004

Response Under 37 CFR § 1.116

Expedited Procedure

Art Unit: 2177

Confirmation No.: 5990

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I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on April 19, 2004, as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, COMMISSIONER FOR PATENTS P.O. Box 1450, Alexandria, VA 22313-1450

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Steven W. Stewart
Attorney for Applicants

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- ☒ Reply Brief (in Triplicate) (fee \$330.00)
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Date: April 19, 2004

Respectfully submitted,

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Steven W. Stewart
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Steven W. Stewart
Attorney for Appellants

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Sir:

Appellants respectfully request reversal of the outstanding final rejections.

This Reply Brief responds to the Examiner's Answer mailed February 20, 2004. (*Please charge any deficiencies to deposit account 50-1071.*)

For the Board's convenience, a copy of the pending claims is attached hereto as Appendix A.

Since the issues are clearly vetted in Appellants' December 11, 2003, Appeal Brief and in this Reply, an oral hearing is deemed unnecessary.

This Reply Brief is provided in triplicate.

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REPLY BRIEF -- 09/578,551

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The following issues are on appeal:

- I. Whether claims 14, 16, 17 and 25 are anticipated under 35 U.S.C. 102 by Davis (U.S. Patent No. 6,269,361 B1).
- II. Whether the Office established a *prima facie* case of obviousness under 35 U.S.C. 103 in rejecting claims 1-5, 7-12, 15, 18-24, 26 and 27 as being unpatentable over Davis in view of Eyal (U.S. Patent No. 6,389,467 B1), when (a) the references – collectively – fail to detail all of the elements claimed, and (b) there is no teaching or suggestion in the art that would have led an artisan to modify and combine the references as proposed.
- III. Whether the Office established a *prima facie* case of obviousness under 35 U.S.C. 103 in rejecting claims 6 and 13 as being unpatentable over Davis in view of Eyal and in further view of Thomas (U.S. patent No. 6,401,118 B1), when (a) the references – collectively – fail to detail all of the elements claimed, and (b) there is no teaching or suggestion in the art that would have led an artisan to modify and combine the references as proposed.

Appellants' December 11, 2003, Appeal Brief establishes that the cited prior art, either alone or in combination, fails to show all of the limitations of the pending claims. As set forth in the Federal Circuit's *In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1693, 2001 U.S. App. LEXIS 17219 (Fed. Cir. Aug. 2, 2001), there is no need to examine whether there is a motivation to combine the cited references if the prior art fails to disclose at least one of the limitations of the claimed invention.

Appellants' Appeal Brief identifies the claim limitations that Davis, Eyal and Thomas, either individually (for claims 14, 16, 17 and 25), and for some claims collectively (for claims 1-6, 7-13, 15, 18-24, 26 and 27) fail to disclose, so there is no need to repeat all of those arguments in this Reply Brief.

Comments on Claims 1 and 4

Briefly, however, Appellants wish to comment on the final rejection of claims 1 and 4, which, surprisingly, are not directly discussed in the Examiner's Response to Argument section.

Claim 4 .

Claim 4 recites deriving an identifier corresponding to an existing media content object, and then querying a database with the derived identifier. If the database has no active record corresponding to the derived identifier, then a party who first queried the database with the identifier is permitted to define such a record.

Appellants are still left to guess as to whether the office intended Davis's "rank value" to met Claim 4's deriving features, which we suppose is the case since the "rank value" appears to be the only value generated in the Davis passage cited by the Office.¹ But Davis' rank value is not used to query a database (*cf.* claim 4: "*querying a database with the derived identifier*"). Instead, a search term – and not the rank value – is used to query the search engine (see Davis at its Abstract, lines 27-31).

Moreover, another cited Davis passage (Col. 4, lines 34-48) contemplates advertisers targeting interested consumers (etc.). In contrast, claim 4 would permit a party who first queried the database with the identifier to define a record.

Eyal is relied upon in the final rejection for "necessary infrastructure,"² and not to remedy Davis's above noted deficiencies. Regardless, Eyal is not understood to teach or suggest: i) deriving an identifier corresponding to an existing media content object, and then querying a database with the derived identifier; and ii) permitting a party who first queried the database with the identifier to define a record, in combination with the other features of claim 4.

We respectfully request that the final rejection of claim 4 be reversed.

¹ The Examiner cited the Davis Abstract at lines 22-34 to meet these claim features.

² See Examiner's Answer, page 8, line 9.

Claim 1

Claim 1 recites receiving a query from a user including an identifier that has no active database record associated therewith, the identifier being derived from an existing media content object, and permitting the user to create an active database record corresponding to the identifier.

Again Davis is deficient in supporting an identifier being derived from an existing media content object in combination with the features of claim 1. A search term – and not a generated “rank value” – is used to identify content in the Davis Scheme. A Davis rank value merely determines a listing order once content is identified.

Appellants note the Office’s related comments in its Response to Argument section,³ where it suggests that Eyal teaches deriving an identifier from existing media content object. We respectfully disagree. The cited Eyal passage (Col. 12, lines 13-17) discusses providing access to media via links found at a media site, but does not support an identifier being derived from an existing media content object.

The combined references also fail to teach or suggest permitting a user to create an active database record corresponding to such a derived identifier.

We respectfully request that the final rejection of claim 1 be reversed.

Remarks regarding Examiner’s Response to Argument section:

Appellants wish to address some of the points raised in the Response to Argument section of the Examiner’s Answer.⁴

³ See the Examiner’s Answer on page 17, 8-12.

⁴ The Examiner’s Answer states that it responds only to a handful of claims; namely, claims 14, 16, 17 and 25 (see, the Examiner’s Answer on page 13, line 6). However, it appears that several other claims are addressed in the Response to Argument section as well.

Appellants' following remarks are organized by claim numbers. Reference to the Examiner's Responses is provided via footnotes to simplify the discussion.

Claim 14

Regarding claim 14, the Examiner suggested that Davis shows a "time-limited" auction.⁵ To support this position, the Examiner cites Davis at Col. 3, lines 59-65, and states that the Davis section teaches "[b]id auction is related with the time."⁶

A careful review of the above cited Davis passage finds no discussion of a time-limited auction (or any mention of "time," for that matter).

The Examiner then cites Davis, at Col. 21, lines 7-13⁷, as showing the feature of, in response to receiving a query corresponding to an inactive identifier, initiating a time-limited auction, a winner of said auction being granted the privilege of associating an internet resource with said identifier for at least a predetermined time period. We disagree.

The cited Davis passage suggests generating a cost prediction for a search listing at a given price bid. *While the cost estimate at a given bid is calculated with respect to a fixed time period, the auction itself is not so limited.* A Davis-like advertiser could enter a higher bid at anytime, where a higher bid can always supplant others. Thus, the cited passage is deficient in teaching the initiation of a time-limited auction, where a winner of the auction is granted the privilege of associating an internet resource with the identifier for at least a predetermined time period, in combination with the other features of claim 14.

We respectfully request that the final rejection of claim 14 be reversed.

⁵ See the Examiner's Answer on page 14, lines 21-22.

⁶ See the Examiner's Answer on page 15, lines 1-6.

⁷ See the Examiner's Answer on page 15, lines 7-14.

Claim 16

Regarding claim 16, the Examiner states “[w]hen auctioning privilege is there [sic] re-auctioning privilege can also be given (col. 21, lines 23-25 et seq).”⁸

As best understood, we respectfully disagree with the Examiner’s position.

The cited Davis passage, instead, deals with generating a projected numbers of days until account funds are exhausted⁹, and not, at an expiry of a predetermined time period, re-auctioning a privilege.

We respectfully request that the final rejection of claim 16 be reversed.

Claim 17

Despite the Examiner asserting that he responded to Appellants’ arguments regarding claim 17¹⁰, we have not been able to identify such a response.

Claim 17 stands rejected over Davis at Col. 21, lines 19-25¹¹.

But this Davis passage fails to discuss sharing of any kind, let alone sharing proceeds of a re-auction with a high bidder of a previous auction.

We respectfully submit that that final rejection of claim 17 should be reversed.

Claim 25

Despite the Examiner asserting that he responded to Appellants’ arguments regarding claim 25¹², we have not been able to identify such a response.

Claim 25 stands rejected over Davis at Col. 16, lines 14-15¹³.

⁸ See Examiner’s Answer on page 15, lines 19-21.

⁹ The cited Davis passage at col. 21, lines 23-25 reads: “The current balance may be divided by the daily run rate to obtain a projected number of days to exhaustion or “expiration” of account funds” (quotations in original).

¹⁰ See Examiner’s Answer on page 13, line 6.

¹¹ See Examiner’s Answer on page 5, lines 12-13.

¹² See Examiner’s Answer on page 13, line 6.

¹³ See Examiner’s Answer on page 5, lines 8-11.

The cited Davis passage, at Col. 16, lines 14-15¹⁴, deals with automatic notification of a pending *account balance*, and not *automatic generation of a content identifier* by a winner's device, without requiring the winner to type or otherwise manually enter the identifier.

We respectfully submit that the final rejection of claim 17 should be reversed.

Claim 27

We note the Examiner's statement that Davis teaches automatically deriving an identifier.¹⁵ We must again disagree.

The cited Davis passage at Col. 14, lines 38-39, invokes a function (in response to a mouse click) that receives data identifying an advertiser and retrieves the advertiser's account from a database (emphasis added). No support for deriving the identifying data from media content is found in the cited Davis passage.

We respectfully request that the final rejection of claim 27 be reversed.

Claim 13

The Examiner states: "Appellant argued that Thomas does not disclose, 'MP3 audio file.'"¹⁶

The Examiner's statement is a mischaracterization of Appellants' position.

A careful review of Appellants' Appeal Brief¹⁷ finds the following, and only the following, characterization of Thomas and MP3 files:

¹⁴ Davis at Col. 16, lines 11-15 read: "A routine will be invoked to update the subaccount balances to reflect the pending balance allocations when the payment for the pending balance is processed. Automatic notification may be sent to the advertiser at that time, if requested.

¹⁵ See Examiner's Answer on page 18, line 20 through page 19, line 2.

¹⁶ See Examiner's Answer on page 16, line 1.

¹⁷ See Appellants' Brief at page 26, line 22 through page 27, line 5.

“The Office has failed to establish a *prima facie* case of obviousness with respect to claim 13.

The fact that Thomas mentions the term “MP3” is not sufficient to render claim 13 unpatentable. Indeed, the Office has failed to discuss how the proposed combination of Davis, Eyal and Thomas teaches such claim features such as automatically generating identifiers from different versions of an MP3, wherein the version have different bits due to the compression and/or bit-rate.

These claim features were not even discussed in the Final Office Action (see page 9, lines 15-24 of paragraph 9), nor are they understood to be supported by the proposed art combination.”

Appellants’ position is that while Thomas mentions the term “MP3,” the mere mention of the term without meeting all the limitations of the claim 13, does not render claim 13 unpatentable.

We respectfully request that the final rejection of claim 13 be reversed.

Conclusion

In view of the foregoing, Appellants respectfully submit that the final rejection of claims 1-27 should be reversed, and the application be returned to the Examiner for issuance of a Notice of Allowability.

(We expressly traverse the Examiner’s characterization for the patentability of the pending claims in view of the applied art.

The Board is respectfully requested to consult our Appeal Brief for our position on any claims not expressly discussed herein.)

The Office is invited to contact the undersigned at 503-495-4575 with any questions.

Date: April 19, 2004

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Respectfully submitted,

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By

A handwritten signature in dark ink, appearing to read 'St SL', written over a horizontal line.

Steven W. Stewart
Registration No. 45,133

Attachment: Appendix A (pending claims)

APPENDIX A
(PENDING CLAIMS)

1. (original): A method of operating a database that has plural records, the method including receiving queries, each including an identifier, and replying to said queries by reference to information from database records associated with said identifiers, said identifiers being drawn from a universe of possible identifiers, a majority of which do not have active database records associated therewith, the method including:

receiving a query from a user including an identifier that has no active database record associated therewith, said identifier being derived from an existing media content object; and
permitting the user to create an active database record corresponding to said identifier.

2. (original): The method of claim 1 that includes allowing the user to pay a fee, said fee entitling the user to specify at least a portion of the database record corresponding to said identifier.

3. (original): The method of claim 1 that includes allowing the user to make a first bid in an auction, said auction continuing for a predetermined period commencing with said first bid.

4. (original): A method comprising:
deriving an identifier corresponding to an existing media content object;
querying a database with the derived identifier; and
if the database has no active record corresponding to said derived identifier, permitting a party who first queried the database with said identifier to define such a record.
5. (original): The method of claim 4 in which the media content object is an audio file.
6. (original): The method of claim 4 in which the media content object is an MP3 audio file.
7. (original): The method of claim 4 in which the media content object is a video file.
8. (original): The method of claim 4 in which the deriving includes consulting a resource external of the media content object.
9. (original): The method of claim 8 in which the resource is a database.
10. (original): The method of claim 4 in which the deriving includes processing data from the media content object to obtain said identifier.

11. (original): The method of claim 4 in which several identifiers can correspond to the same media content object.

12. (original): The method of claim 11 in which the identifiers are automatically generated from different releases of an audio CD, wherein the releases have different audio and/or table of contents.

13. (original): The method of claim 11 in which the identifiers are automatically generated from different versions of an MP3 file, wherein the versions have different bits due to the compression and/or bit-rate.

14. (previously presented): A method of managing a universe of identifiers, some of said identifiers being active and having internet resources associated therewith, and others of said identifiers being inactive, the method including receiving a query corresponding to an inactive identifier and, in response, initiating a time-limited auction, a winner of said auction being granted the privilege of associating an internet resource with said identifier for at least a predetermined time period.

15. (original): The method of claim 14 in which said active identifiers correspond to different audio content, and the internet resources corresponding to said active identifiers correspond to said audio content.

16. (original): A method comprising:
 auctioning to the highest bidder the privilege of defining a link that is to be associated,
for a predetermined time period, with an identifier through a database; and
 at the expiry of said predetermined time period, re-auctioning said privilege.

17. (original): The method of claim 16 in which the proceeds of said re-auctioning are
shared with the high bidder of a previous auction for said privilege.

18. (original): The method of claim 16 in which the identifier corresponds to an existing
media content object.

19. (original): The method of claim 18 in which the identifier is derived, rather than
assigned.

20. (previously presented): The method of claim 1 wherein a primary function of the
database is to link consumers to internet resources, such as web pages, that promote goods or
services that are related to the media content objects and that are offered by commercial entities,
and said user is one of said consumers, wherein the consumer can participate in such linking in a
manner customarily reserved to the commercial entities.

21. (previously presented): The method of claim 1 that includes automatically providing the identifier from a process on a user device - such as a computer - to the database, without requiring the user to type or otherwise manually enter the identifier.

22. (previously presented): The method of claim 4 wherein a primary function of the database is to link consumers to internet resources, such as web pages, that promote goods or services that are related to media content objects and that are offered by commercial entities, and said party is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities.

23. (previously presented): The method of claim 1 that includes automatically providing the identifier from a process on a device maintained by said party - such as a computer - to the database, without requiring said party to type or otherwise manually enter the identifier.

24. (previously presented): The method of claim 14 wherein said identifiers and internet resources are associated through a database, a primary function of which is to link consumers to internet resources that promote goods or services that are related to media content objects and that are offered by commercial entities, and said winner is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities.

25. (previously presented): The method of claim 14 that includes automatically deriving the identifier using a device maintained by said winner, without requiring said winner to type or otherwise manually enter the identifier.

26. (previously presented): The method of claim 16 wherein a primary function of the database is to link consumers to internet resources that promote goods or services that are related to media content objects.

27. (previously presented): The method of claim 16 that includes automatically deriving the identifier from a media content object.